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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,041	02/01/2002	Don Coppersmith	YOR920020025US1	3936

7590 10/06/2006

IBM CORPORATION  
INTELLECTUAL PROPERTY LAW DEPT.  
P.O. BOX 218  
YORKTOWN HEIGHTS, NY 10598

EXAMINER

NOBAHAR, ABDULHAKIM

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/066,041	<b>Applicant(s)</b> COPPERSMITH ET AL.	
	<b>Examiner</b> Abdulhakim Nobahar	<b>Art Unit</b> 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is in response to applicants' response received on July 21, 2006.
2. The amendments of claims 1, 9, 17, 19 and 20 are acknowledged.

### ***Response to Arguments***

Applicants' arguments have been fully considered but they are not persuasive.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-20** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicants in order to overcome the 101 rejections presented in the previous office actions have amended the claims in such a manner that the issue of non-statutory of the claims is still remained unresolved.

Claims 1 and 9 combining a generic processor and disembodied non-functional descriptive material (a state, a function and a table). In order for these claims to be statutory, applicants should properly claim a true machine in the form of a system with hardware and software components which are functionally interrelated in such a manner as to enable a random output stream to be generated and used for encryption.

Regarding claim 17, regardless of the recitation of "a computer implemented method", concatenating the outputs is purely non-functional descriptive of a mathematical operation which formulates the output stream but does not necessarily bring it into a form which enables its use, the claim is non-statutory for failing to provide a tangible result which enables any usefulness in the disclosed practical application of encryption to be realized.

Regarding claim 19, there is no indication in the specification to regard the medium as physical articles or objects, which are structurally and functionally interrelated to the program product in such a manner as to enable the product to act as a computer component and realize its functionality. Thus, regardless of the claimed computer readable medium the claim 19 recites a description of a computer program product that makes it non-statutory.

Regarding claim 20, this claim is non-statutory because applicants neither disclose nor suggest any embodiment or descriptions in the specification that one of ordinary skill in the art would reasonably interpret the means for performing the recited functionality would require hardware components. On the contrary, one of ordinary skill in the art would understand from the specification that all of the recited means are software subroutines. Thus, the claim 20 is reasonably interpreted as a system of software alone, functional descriptive material, and would be non-statutory.

***Allowable Subject Matter***

Claims 1, 9, 17, 19 and 20 would be allowable if rewritten or amended in conjunction with the specification to overcome the rejections under 35 U.S.C. 101, set forth in this Office action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdulhakim Nobahar whose telephone number is 571-272-3808. The examiner can normally be reached on M-T 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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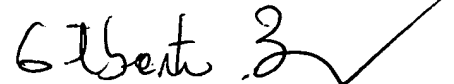
USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 20, 2006

Abdulhakim Nobahar

Examiner

Art Unit 2132 *A.N.*

A handwritten signature in black ink, appearing to read "Gilberto Barron Jr.", with a large checkmark to the right.

GILBERTO BARRON JR  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100